

**REMARKS**

In response to the Final Office Action dated May 17, 2004, the Applicants respectfully request continued examination based on the above amendments and the following remarks.

The Office finally rejected claims 1, 4-11, and 14-17 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent 5,884,202 to Arjomand. Claim 2 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Arjomand* in view of U.S. Patent 6,362,720 to Razavi *et al.* Claim 12 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Arjomand* in view of “official notice.” Claims 3 and 13 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Arjomand* in view of U.S. Patent 6,351,221 to Phillips *et al.* The Applicants show, however, that claims 1, 4-11, and 14-17 are not anticipated, and that claims 2, 3, 12, and 13 are not obvious. The Applicants, then, respectively submit that the pending claims 1-17, and the newly presented claims 18 & 19, are ready for allowance.

**Rejection of Claims Under 35 U.S.C. § 102**

The Office rejected claims 1, 4-11, and 14-17 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent 5,884,202 to Arjomand. A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8<sup>th</sup> Edition) (hereinafter “M.P.E.P.”). As the Applicants show, however, claims 1, 4-11, and 14-17 are patentably distinguishable over *Arjomand*. The reference to *Arjomand* does not anticipate claims 1, 4-11, and 14-17, and the Applicants respectfully request allowance of these claims.

Independent claims 1 and 11 are not anticipated by *Arjomand*. Claim 1 has been amended to require “automatically wirelessly communicating the diagnostic message independent of a command from a service diagnostic tool for obtaining the diagnostic message.”

Independent claim 11, likewise, has been amended to include “*wirelessly communicating the diagnostic message independent of a command from a service diagnostic tool obtaining the diagnostic message.*” Claims 1 and 11 have been amended to emphasize that no service diagnostic tool is required to obtain diagnostic messages. Because no service diagnostic tool is required, any diagnostic message is wirelessly communicated independent of the service diagnostic tool.

*Arjomand* makes no such teaching. *Arjomand* requires the use of a service diagnostic tool to obtain diagnostic messages from a vehicle. *Arjomand* describes a “modular, wireless diagnostic, test, and information system” that connects to a vehicle’s engine control module (see, e.g., column 6, lines 21-24). *Arjomand*’s system has an instrumentation module “to which are connected various cables from the electrical systems or components of a motor vehicle … in connection with evaluation and diagnosis of a vehicle” (column 6, lines 25-31). Claims 1 and 11, however, emphasize that no service diagnostic tool is required by this invention. That is, a diagnostic message is wirelessly communicated “independent of the service diagnostic tool.” The reference to *Arjomand*, then, cannot anticipate claims 1, 4-11, and 14-17, so the Applicants respectfully request removal of the § 102 rejection of these claims.

Moreover, *Arjomand* requires a command sequence. Claim 1 requires “*automatically wirelessly communicating the diagnostic message independent of a command from a service diagnostic tool* for obtaining the diagnostic message” (emphasis added). *Arjomand*, however, in contradistinction to Claim 1, does not “*automatically*” wirelessly communicate a diagnostic message. As the Applicants previously explained, and as *Arjomand* repeatedly explains, a user of *Arjomand*’s system must issue a command to wirelessly communicate diagnostic information. As *Arjomand* states, the “user operates the combined user interface and main control module 12 to control the system” (column 9, lines 39-41). The “wireless networked modules also include at least one remotely operated instrumentation module to perform various measurements and/or provide data under command of the user interface and main control module” (column 3, lines 28-31) (emphasis added). “[T]he user interface module commands the remotely operated main control module to execute diagnostic routine … by wireless

*communication*" (column 3, lines 33-37) (emphasis added). "*The unique attribute of this embodiment of the invention is* that the combined user interface and main control module is provided with *an interactive display that commands the remotely operated instrumentation modules over a wireless communication link*" (column 3, lines 59-65) (emphasis added). "The user interface module communicates with a separate *remotely operated* main control module by wireless communication" (column 4, lines 2-4) (emphasis added). The "*user interface and main control module 12 provides information to the user and receives commands from the user to process or communicate* to the VCI instrumentation module 14 and/or the DVOM instrumentation module 16 *by wireless communication*" (column 5, lines 48-54) (emphasis added). "*The user interface and main control module 12 executes diagnostic application programs and commands the VCI instrumentation module 14 to provide status information and exercise various systems of the motor vehicle and also commands the DVOM instrumentation module to perform measurements and provide measurement data*" (column 9, lines 51-57) (emphasis added).

*Arjomand*, then, cannot anticipate independent claims 1 and 11 of this application. *Arjomand* requires the use of a service diagnostic tool to obtain diagnostic messages from a vehicle. *Arjomand* also requires that a user issue commands to wirelessly communicate diagnostic information. *Arjomand*, then, cannot anticipate claim independent claims 1 and 11 of this invention. The Applicants, then, respectfully ask Examiner Nguyen to remove the § 102 rejection of claims 1, 4-11, and 14-17.

**Rejection of Claims Under 35 U.S.C. § 103**

Claim 2 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Arjomand* in view of U.S. Patent 6,362,720 to Razavi *et al.* Claim 12 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Arjomand* in view of "official notice." Claims 3 and 13 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Arjomand* in view of U.S. Patent 6,351,221 to Phillips *et al.* If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so

found either in the references themselves or in the knowledge generally available to one of ordinary skill”; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter “M.P.E.P.”). As the Applicants show, however, dependent claims 2, 3, 12, and 13 are not obvious in light of any combination of *Arjomand*, *Razavi*, *Phillips*, and/or “official notice.” The Applicants, then, respectfully request allowance of these claims.

### **1. The Prior Art Does Not “Teach or Suggest” The Limitations of Claims 2**

Claim 2 is not obvious. Claim 2 depends from independent claim 1 and thus incorporates the same patentable features. The proposed combination of *Arjomand* and *Razavi* still fails to teach “*automatically wirelessly communicating the diagnostic message independent of a command from a service diagnostic tool for obtaining the diagnostic message.*” Examiner Nguyen is correct — *Razavi* teaches a “global positioning system (GPS) receiver ... coupled to in-car sub-network 20 for providing automobile location information” (U.S. Patent 6,362,720 to *Razavi et al.*, column 6, lines 60-62). The proposed combination of *Arjomand* and *Razavi*, however, still requires a command from a service diagnostic tool to wirelessly communicate diagnostic information with a vehicle’s location. Thus, one of ordinary skill in the art would not have thought it obvious to combine and/or modify *Arjomand* and *Razavi* to obviate claim 2. The prior art does not “teach or suggest” the limitations of claim 2, so any *prima facie* case must fail. The applicants, then, respectfully ask Examiner Nguyen to remove the § 103 rejection of claim 2.

### **2. The Prior Art Does Not “Teach or Suggest” The Limitations of Claim 12**

Claim 12 is also not obvious. The proposed combination of *Arjomand* and *Razavi*, as described above, fails to teach “*wirelessly communicating the diagnostic message independent of a command from a service diagnostic tool obtaining the diagnostic message.*” Thus, one of ordinary skill in the art would not have thought it obvious to combine and/or modify *Arjomand* and *Razavi* to obviate claim 12. The prior art does not “teach or suggest” the limitations of claim

12, so any *prima facie* case must fail. The applicants, then, respectfully ask Examiner Nguyen to remove the § 103 rejection of claim 12.

The Applicants also respectfully disagree with the Examiner. The final office action states that claim 12 merely “gives the vehicle user a choice” to select an option and is thus “old and well known.” The final office action again compares claim 12 to cell phone voice-mail messages. As the Applicants stated in response to the first office action, this comparison is erroneous. Never, ever, has an occupant of a vehicle been requested to initiate a wireless communication representing a diagnostic message “independent of a command from a service diagnostic tool obtaining the diagnostic message.” Never has the occupant been requested to initiate wireless communication in response to the diagnostic message. Heretofore the occupant merely receives a “check engine,” “maintenance required,” “service soon,” or similar warning light. Even the patent to *Razavi* explains that owners of automobiles are not permitted to access nor interact with on-board diagnostic systems. As *Razavi* states, the “owner of the automobile may be allowed to access substantially all of the components and functions of the in-car sub-network *except for detailed vehicle diagnostic information* (U.S. Patent 6,362,730 to *Razavi et al.* at column 7, lines 34-37) (emphasis added). The on-board diagnostic (OBD) systems are of a “*proprietary design which was not originally intended to be connected to a network*” (*Razavi* at column 7, line 65-column 8, line 1) (emphasis added). Claim 12, then, cannot be “old and well-known” when occupants have heretofore never been requested to initiate the wireless communication in response to the diagnostic message. Thus, one of ordinary skill in the art would not have thought it obvious to combine and/or modify *Arjomand* and *Razavi* to obviate claim 12. The *prima facie* case must fail, so the applicants respectfully ask Examiner Nguyen to remove the § 103 rejection of claim 12.

The proposed combination of *Arjomand* and *Razavi* also fails to teach any request to an occupant of the vehicle to initiate wireless communication in response to the diagnostic message. Neither *Arjomand* nor *Razavi*, in fact, mentions any type of “request” procedure to initiate wireless communication in response to the diagnostic message. The proposed combination of *Arjomand* and *Razavi*, as explained above, requires that a user issue commands to wirelessly

communicate diagnostic information with a vehicle's location. Thus, one of ordinary skill in the art would not have thought it obvious to combine and/or modify *Arjomand* and *Razavi* to obviate claim 12. The prior art does not "teach or suggest" the limitations of claim 12, so any *prima facie* case must fail. The applicants, then, respectfully ask Examiner Nguyen to remove the § 103 rejection of claim 12.

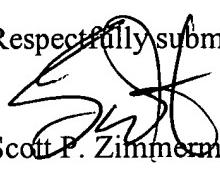
**3. The Prior Art Does Not "Teach or Suggest" The Limitations of Claims 3 & 13**

Claims 3 and 13 are not obvious. Claim 3 depends from independent claim 1, and claim 13 depends from independent claim 11. Claims 3 and 13, then, incorporate the same patent features. The proposed combination of *Arjomand* and *Phillips*, therefore, still fails to teach "initiating a wireless communication in response to the diagnostic message." The proposed combination of *Arjomand* and *Phillips*, as explained above, still requires that a user issue commands to wirelessly communicate diagnostic information. Thus, one of ordinary skill in the art would not have thought it obvious to combine and/or modify *Arjomand* and *Phillips* to obviate claims 3 and 13. The prior art does not "teach or suggest" the limitations of claims 3 and 13, so any *prima facia* case must fail. The applicants, then, respectfully ask Examiner Nguyen to remove the § 103 rejection of claims 3 and 13.

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If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or [scott@scottzimmerman.com](mailto:scott@scottzimmerman.com).

Respectfully submitted,



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